

Amendment and Response

Applicant: Kenneth M. Adams et al.

Serial No.: 10/657,915

Filed: September 9, 2003

Docket No.: M190.145.101 / P-263.00 US

Title: SURGICAL MICRO-BURRING INSTRUMENT AND METHOD OF PERFORMING SINUS SURGERY

REMARKS

This is responsive to the Non-Final Office Action mailed March 3, 2009. In that Office Action, claims 1-13, 15-24, and 31-36 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 10, 13, 15-20, 22, 23, 31, 32, and 34-36 were rejected under 35 U.S.C. §102(b) as being anticipated by Anctil et al., U.S. Patent No. 5,922,003 ("Anctil"). Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Anctil. Claims 2-9, 11, 12, and 33 were rejected under 35 U.S.C. §103(a) as being unpatentable over Anctil in view of Adams, U.S. Patent No. 6,503,263 ("Adams"). Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Anctil in view of West, Jr., U.S. Patent No. 5,364,395 ("West").

The claims remain unchanged with this response. Claims 1-13, 15-24, and 31-36 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §112, Second Paragraph, Rejection

With regard to the limitation of "a proximal portion proximal the pocket, the proximal portion forming a tube", Applicant submits that this language is clear and meets the requirements of 35 U.S.C. §112, second paragraph. As is known to one skilled in the art, a lumen is an open space or cavity of a tubular structure whereas a tube is a cylindrical structure. Furthermore, the "outer tubular member" of claim 1 includes the recited "tube" and is not be strictly interpreted as only meaning a "tube". With reference to FIG. 1, which is reproduced below, outer tubular member 18 refers to the elongated body extending distally from hub 16.

**Fig. 1**

The outer tubular member 18 includes proximate section 40, intermediate section 42 and distal section 44. A clear demarcation is illustrated in FIG. 1 (as reproduced above) between intermediate section 42 and distal section 44. Moreover, the drawings clearly indicate a tube of the distal section of the outer tubular member. For example, FIG. 4A clearly illustrates a tube in

Amendment and Response

Applicant: Kenneth M. Adams et al.

Serial No.: 10/657,915

Filed: September 9, 2003

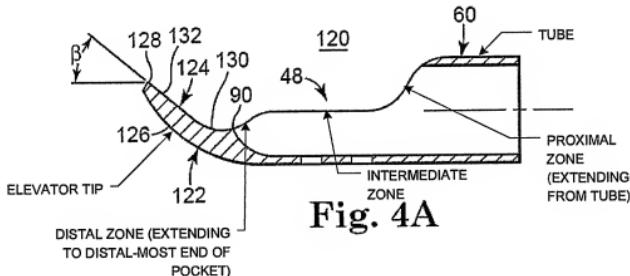
Docket No.: M190.145.101 / P-263.00 US

Title: SURGICAL MICRO-BURRING INSTRUMENT AND METHOD OF PERFORMING SINUS SURGERY

the distal section as an extension of the central lumen 46 on the right-hand side of FIG. 4A. Thus, the "tube" referred to is the tubular portion of distal section 44 extending from the intermediate section 42. As a result, it appears that this rejection is improper and Applicants respectfully request that this rejection be withdrawn.

35 U.S.C. §§102, 103 Rejections

Anctil describes a cutting instrument with an outer tubular member having a distal end with serrations along its length. The Office Action alleges that the serrations teach the proximal zone, intermediate zone and distal zone recited in claim 1. Applicant respectfully disagrees. Claim 1 clearly recites, "a distal zone extending from the intermediate zone to a distal-most end of the pocket at which the central lumen terminates". Moreover, claim 1 recites an elevator tip extending distal the pocket. One embodiment of the claimed invention is shown below, clearly pointing out an example of the claimed features of the distal section.



The claimed features shown above are clearly distinguished from Anctil. The serrations of Anctil simply fail to teach or reasonably make obvious the proximal, intermediate and distal zones or the elevator tip as claimed. First, the alleged proximal zone of Anctil pointed to in the Office Action does not extend from the proximal portion as defined in claim 1. Instead, the alleged proximal zone is arbitrarily chosen as positioned somewhere between an intermediate section of an outer tubular member and the alleged intermediate zone of the distal section. Thus,

Amendment and Response

Applicant: Kenneth M. Adams et al.

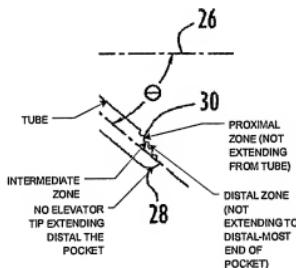
Serial No.: 10/657,915

Filed: September 9, 2003

Docket No.: M190,145.101 / P-263.00 US

Title: SURGICAL MICRO-BURRING INSTRUMENT AND METHOD OF PERFORMING SINUS SURGERY

the alleged proximal zone of Anctil does not extend "downwardly from the proximal portion" as recited in claim 1. In addition, Anctil clearly does not teach or reasonably make obvious an elevator tip as disclosed and claimed. The Official Action merely alleges that the "distal-end of device" describes an elevator tip. Applicant respectfully disagrees and notes the distal-end of the Anctil device merely forms an end of the pocket and does not extend in an elevated fashion distally from the pocket. As is best understood from the drawing provided in the Office Action, below is a reproduction of the alleged teachings of Anctil.



Based on the above drawing, the serrations of Anctil simply fail to teach or reasonably make obvious the distal section recited in claim 1. Simply, there is no objective evidence in Anctil of proximal zone extending from a tube, a distal zone extending to a distal-most end of a pocket or an elevator tip extending distal the pocket.

Adams and West simply fail to cure the deficiencies of Anctil. Neither Adams nor West disclose the zones recited in claim 1 and simply fail to reasonably make obvious features recited in the dependent claims. As such, independent claim 1 and claims 2-13, 15-24 and 31-36 depending there from are believed to be allowable. Thus, withdrawal of the rejections under 35 U.S.C. §§102 and 103 is respectfully requested.

Amendment and Response

Applicant: Kenneth M. Adams et al.

Serial No.: 10/657,915

Filed: September 9, 2003

Docket No.: M190,145,101 / P-263.00 US

Title: SURGICAL MICRO-BURRING INSTRUMENT AND METHOD OF PERFORMING SINUS SURGERY

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-13, 15-24, and 31-36 are in form for allowance and are not taught or reasonably made obvious by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-13, 15-24, and 31-36 are respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to Todd R. Fronek at Telephone No. (612) 767-2522, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

Dicke, Billig & Czaja, PLLC

Attn: MD Matters

Fifth Street Towers, Suite 2250

100 South Fifth Street

Minneapolis, MN 55402

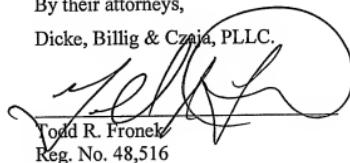
Customer No. 63496

Respectfully submitted,

Kenneth M. Adams et al.,

By their attorneys,

Dicke, Billig & Czaja, PLLC.



A handwritten signature in black ink, appearing to read "Todd R. Fronek".

Todd R. Fronek
Reg. No. 48,516

Date: 6/3/07
TRF:skh